Applicant's response of 09/13/11 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9,11-13,19,21-24,34, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 1-9,11-13,19,21-24,34, applicant has amended the claim to contain new matter that is not supported by the specification, claims, and figures as originally filed. The instant examiner has reviewed the originally filed specification numerous times. The examiner could not find where the original specification disclosed that the client network device was comprised of more than one processor, which is in the claimed scope. The claim recites “a client device with at least one processor". This appears to be new matter. The registration system server was disclosed as being able to be more than one server/processor, but the examiner could not find any disclosure to the client device having *more than one* processor. Claim 1 contains new matter that is not supported by the specification as originally filed. For claim 34, in a similar analysis to that of claim 1, claim 34 contains the same new matter issues and problems. Claim 34 is rejected for the same reasons as claim 1 with respect to new matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9,11-13,19,21-24,34, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1 (and claim 34), applicant has amended the claim to recite"

"creating an additional contract laver associated with the electronic permanent registration certificate on the permanent domain name system server with one or more additional rights included the additional contract layer comprising: issuing a domain name registration title, issuing an insurance policy, issuing a plurality of ownership shares, issuing leases or sub-leases or issuing co-ownership certificates for the issued electronic permanent registration certificate with the additional contract laver,"

The scope of this language is not clear. What is meant by creating an additional contract layer associated with the permanent registration certificate? A contract is an abstraction that represents some sort of agreement between at least two parties. Is this claiming that language describing a contract is included with the registration certificate? How many of the claimed "rights" are even being claimed, if any at all? The claim recites "with one or more additional rights *included the additional contract layer*". The examiner notes that this reads poorly and the portion that recites "included the additional contract layer" is awkward and needs correction. Are the rights included "in" the additional contract layer? Is that what the claim is attempting to recite? One wishing to avoid infringement would not be clear as to what the creation of an additional

contract layer was referring to. Are any of the claimed “rights” being issued in the claim scope? The way the language appears to read, a contract layer is created that has some sort of right included in the contract layer. The creation of a contract with an associated right is an abstraction that is not really creating anything in the real world other than that which human beings would recognize in their minds. That is all that is claimed as best the examiner can tell, the creation of a contract with certain conditions or rights. The portion of the claim that is describing the rights as being issuing an insurance policy, or issuing a title, etc., is this positively reciting a step of issuing anything? Or, is this merely language that is describing the rights that are part of the contract layer in a descriptive sense, like the terms of a contract would be considered as rights which are part of the contract? It is not clear to the examiner if the claim requires that anything is being issued in the form of any rights. Confusion is also noted as being present due to claim 4 (as an example). In claim 4, it recites that the method “further comprising issuing a domain name registration insurance policy” as “a first additional right in the additional contract layer”. Does this mean that claim 4 is issuing an insurance policy in addition to having one of the rights in claim 1 also being issued? This would be due to the “with one or more rights included the additional contract layer comprising: issuing….” that seems to imply that only one right is being claimed as being issued in claim 1. However, claim 4 recites that the issuing of the insurance policy is a "first additional right". Is this an additional right in addition to one of the claimed rights of claim 1 (that can itself be the issuing of an insurance policy because of the broad claim language), or is this the only right that has been issued at this point in the claims and

the language of claim 1 is merely descriptive in nature and describing what the rights provide for if they were to be issued. It is not clear in what claim the issuing step is occurring. Is it in claim 1 where one of the rights are being issued, where another right is issued in the form of an insurance policy in claim 4? Or is there nothing being issued in claim 1 and the first occurrence of any right being issued is recited in claim 4 (as an example)? This is not clear and renders the claims indefinite. Claims 4,5,6,7,8, recites that the other rights are issued, each one individually depending from claim 1. These claims contain the same issue as the examiner has addressed for claim 4. For purposes of examination the examiner will consider claim 1 as reciting that at least one right is being issued as a part of the method claim, where claims 4-8 are taken as further specifying what that specific right is that was issued in claim 1 where the claims only require that one right be issued from the claimed grouping of potential rights. These claims have been interpreted as they are best understood by the examiner.

For claim 2, the language of “receiving a request on a permanent domain name system server at least one processor from a client network device" reads poorly and is confusing. What is the “at least one processor" part related to and referring to? This portion of the claim is confusing and is considered to be indefinite.

For claim 34, applicant has amended the claim to now recite a computer readable medium that has instructions “which when executed by at least one processor cause the at least one processor to perform a plurality of **steps**: “**for** receiving…”, “**for** obtaining…”, “**for** accepting...”, “**for** creating…”, etc.. The claim is now reciting a plurality of “**step for**” limitations. This raises two issues in the opinion of the examiner

that render the claim indefinite. Applicant is either using 112,6th limitations due to the language of “step for”, or applicant is not defining what the actual steps are that are being claimed and therefore it is not clear at all what is even being claimed. The examiner assumes that applicant is invoking 112,6th due to the use of "step for” and then specifying a function that the step is to accomplish. This sure seems like invocation of 112,6th to the examiner. An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. Due to the use of language that falls into 112,6th paragraph, upon reviewing the specification the issue still remains as to what the covered structure is. The examiner stated the following with respect to the use of "means for" in claim 34, that applicant has simply changed the language to be "step for". This is still invoking 112,6th paragraph as best the examiner can tell based on what a proper 112,6th limitation is per 35 USC 112,6th itself.

Applicant’s usage of means plus function language is considered to render the claim indefinite. Applicant is claiming numerous means plus function limitations. Applicant has claimed a “step for receiving a request” for renewal of a registration. What structure does this cover from the specification? The specification may disclose that a request is received, but that is not sufficient to convey what the covered structure is. The same is found for the “step for obtaining information”. What is the covered structure? This is not clear. Applicant claims a “step for accepting”. What is that

specifically as far as structure is concerned? It is not clear what is covered by this language after consulting the specification. With respect to the "step for creating an electronic record", the specification does not disclose what the covered structure is. The specification may disclose that an electronic record is created, but that is not enough to satisfy the requirement to disclose what the covered structure of the means plus function language is under 112,6th. For the step for creating limitation, it is not clear what structure covers this language. Where did the specification disclose the structure that is used to accomplish the act of creating an electronic record as claimed? It was disclosed that an electronic record was created, but the structure by which it is created is not disclosed and is not at all clear. The step for adding language has the same problem. What structure to the system is disclosed as accomplishing the act of adding a second portion of the fee to an investment instrument that can pay for all future fees? What structure does this? From the specification, as best the examiner can tell, the means to add the portion of the fee to an investment is a person and has nothing to do with the machine. The same is found for the limitations of the means for issuing and means for providing access. It is not clear what the associated structure is from the speciation that this 112,6th language covers.

The examiner would additionally question where the specific algorithms have been disclosed for the claimed means plus function language. Using means plus function language does not relieve applicant from the duty to provide the actual algorithm as far as the specific steps that the computer would perform to accomplish the recited functions. The mere disclosure to a generic computer is not sufficient to satisfy

the burden to disclose the covered structure when using a 112,6th limitation. What algorithm (what actual steps) are performed by a computer to allow the receipt of a request to occur? What algorithm (what actual steps) are performed by a computer to allow the creation of an electronic record to occur? What algorithm (what actual steps) are performed by a computer to allow the portion of the fee to be added to a financial instrument? The same is applicable for the remaining limitations to claim 34. The identification of the covered structure (including the algorithm) is not clear from reviewing the originally filed specification and renders the claim indefinite. Prior art has been applied to claim 34 as the claim is best understood by the examiner.

Additionally, if applicant argues that they are not using 112,6th, which would require amending the claims in the opinion of the examiner, then it is not clear what the actual steps are that are being claimed. The claimed instructions are causing a processor to perform a plurality of steps for doing certain functions. What are the actual steps claimed? If the instructions are steps for doing what is claimed, then that is identifying just the result of the unknown steps and is not reciting what the steps are in a positive sense. If this language is not 112,6th, then the examiner has no idea what steps are required in the claim scope because the claims merely recite what the steps are for, which is not reciting what the actual steps are.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-9,11-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellman (20020065903) in view of Loeb et al. (6014641) and further in view of "Lifetime service now offered" (1997).

For claims 1,2,3,11,12, Fellman teaches a domain name registration system that can be used to registration a domain name. In paragraph 007, Fellman discusses what a “registrar” is and discusses the fact that the registrar can interact with the authoritative database (ICANN) for purposes of checking and registering domain names. The registrar is basically acting as an agent of the user to affect the domain name registration. In paragraph 32 it is disclosed that a user computer (*client device*) is used to send a *request for a domain name registration* to a *web server 110* via the *Internet*. Fellman is basically directed to a registrar system that provides the service of registering domain names on behalf of a user with the governmental and authoritative database for domain name registrations (ICANN). Fellman teaches that it was well known in the art to use the Internet to communicate with a domain name server (110) for the purpose of registering a domain name. Fellman teaches the overall idea of accepting and processing a domain name registration via the Internet. The limitation that refers to the server as a “permanent domain name system server”, a server is a server and the term “permanent" is nothing but a descriptive term that defines no

structure to the claimed server. The server of Fellman satisfies the claimed domain name system server. Fellman discloses that the user pays a fee for the domain name registration being provided by the registrar. Figure 3 is an example where it can be seen that the user is given a message in the form of a textual display that informs them of how much it costs to register a domain name. A “Begin Registration" button can also be seen in figure 3. Figure 3 also shows a pricing and services link on the left side. Also disclosed by Fellman is the *creation* and *issuing* of a *registration electronic record* for the existing domain name. The term “permanent” is noted as being used to describe the created and issued record; however, this term is not defining anything further to the record itself or the data contained therein. Figure 10 is representative of an electronic record that has been displayed to the customer in the form of a registration certificate (*access has been provided to the customer* as claimed). Upon successful registration a user is presented with a display that is considered to satisfy the claimed *electronic registration record*. The user is presented with information regarding the successful registration of the domain name, the expiration date, and information on how much money has been charged to a credit card in the form of a payment fee for the domain name registration. All of this is stored in a database. Fellman inherently has accepted a fee payment electronically as is evidenced by figure 10 , "*Your credit card has been charged $275.00*". Fellman receives a fee from the client device to the domain name server as claimed.

Not disclosed by Fellman is that the domain name registration that the user has requested is for a domain name registration *renewal* as opposed to a first time

registration of a new domain name. Also not disclosed is the issuance of a permanent registration certificate that uses the created electronic registration record. Also not disclosed and that which follows from the nature of renewals, is that a list of domain names is periodically generated as claimed, with transferring of the fees from the financial instrument, and paying the renewal fees for the domain name registration renewal. Not disclosed is the querying of the registrar to determine that all renewal fees have been paid. The above all flows from the renewal of a domain name registration as will be addressed.

Also not disclosed is that a one time permanent registration fee is accepted, where the one time payment is a one time registration fee for the domain name registration renewals.

Not disclosed is the use of a financial instrument (adding the second portion...) as claimed that allows for profits to be made on a portion of the fee payment, so that future payments for domain name registration renewals can be made.

Also not disclosed is the last portion of the claim that recites that enforcement and resolution of disputes is provided “that with a third party”.

With respect to the limitation that the request for the domain name registration is for a continued renewal of the domain name, as stated above, this is not taught by Fellman. The examiner notes for the record that there is no disputing the fact that domain name renewals were known prior to the filing date of the instant application, and that this had to be done through a system such as Fellman that communicates with a domain name registry (ICANN). This is evidenced by the Tonga reference of record as

well as from applicant's specification where it is disclosed that domain name renewals exist and have certain problems associated with them. One of ordinary skill in the art would very much understand that domain name registrations need to be renewed (because they have been limited in their registration length and need to be renewed) and would very much understand that this is done via a registration system operated by a registrar (Fellman). One of ordinary skill in the art would have found it obvious to use Fellman to affect a domain name registration renewal, because domain name renewals are something that is unquestionably well known in the art.

With respect to the concept of acting as an agent for the user and for providing the services of providing automated domain name registration renewals, the examiner cites to Loeb. Loeb is directed at a system that allows a third party (an agent) to act on behalf of a customer and automatically renew subscriptions for them on a recurring basis into the future. Specifically, Loeb is directed at a system that provided for open ended availability to commodity items that are normally only available to consumers through a renewable term based subscription. See column 1, lines 9-15. Also see column 3, lines 54-67. While Loeb is using the example of a magazine subscription, in more than one location Loeb has made it clear that the invention can be used with any type of commodity item that is normally only available to consumers through a renewable term based subscription (col. 3, lines 63-67). One of the problems that Loeb is addressing is the fact that the consumer has to renew their subscription before it expires and that this presents an inconvenience to the consumer. In column 2, lines 10-14 it is disclosed that inadvertent failure to return a renewal in a timely fashion may

result in sudden disruptions in the service being provided. In column 11, lines 38-51 it is disclosed "one advantage of the invention is that consumers are empowered to obtain open-ended subscriptions to commodity items, such as magazines, normally only available to consumers through renewable term based subscriptions. It is disclosed that another advantage is that renewal notices and associated billings are eliminated. Also disclosed is that the risk of having the service disruption is avoided by the automatic renewal on behalf of the customer. In an overall sense, Loeb is disclosing the act of providing open ended services to a consumer to affect the renewal of a term based subscription to some sort of commodity. Loeb is not limited to magazines and is extending the teachings to any commodity that has a term based subscription. A domain name registration is a term based subscription in a broad sense. A person wishing to maintain a domain name needs to renew their registration, just like a person wanting to continue a magazine subscription would have to renew their subscription. It is known in the art for a third party in the form of an agent to act on behalf of a consumer and offer the services of an "open-ended" renewal service that can renew a service on behalf of the customer. The agent in Loeb is equivalent to the registrar in Fellman. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Fellman with the ability to provide for "open-ended" renewals of domain name registrations for the same reasons as disclosed by Loeb, which just happen to be essentially the same reasons that applicant has disclosed in the specification that they are providing by their domain name renewal registrations. Applicant is offering the services of domain name registration renewals so the consumer

does not have to deal with it and so that they do not accidentally forget to renew their registration. This is the same reasoning that Loeb discloses for having automated registration renewals and is why Loeb discloses that there are advantages to having the renewal process handled by a third party (registrar of Fellman). The registration renewal is for a previously registered domain name that also has associated information stored in a public domain registry (the ICANN registry).

With respect to the claimed step of obtaining information from the public registry, this is considered to flow from and be satisfied by the prior art combination of record. To do a renewal on behalf of a customer, Loeb discloses that the customer must provide information on what it is they desire to have renewed. See column 4, lines 28-47 of Loeb where it is disclosed that orders for renewals can be submitted electronically via the Internet. In column 7, lines 29-34 Loeb discloses that an order record is created, which is equivalent to the registration record in Fellman which is created in response to the order information being received from a customer. Column 8, lines 21-38 discloses that customer can convert their subscription to an open ended type. This involves the system of Loeb obtaining information from the supplier (who in Fellman is ICANN). When modified in view of Loeb, Fellman is going to be receiving an order from a customer for a domain name registration renewal, and will query the supplier (the public registry database) for information. This information is used to process the renewal request from the customer. The specifics of the renewal process of Loeb have been provided to Fellman and this includes the act of obtaining information from the public domain registry pertaining to the existing domain name that renewal is requested for.

Loeb discloses that the information can come from the customer or can be obtained from the supplier, which in the case of domain name registrations, means that ICANN is queried to obtain information on the domain name having its registration renewed. With respect to the portion of the claim that is reciting that the electronic record is used to determine and very current and future fees payments due, this is directed at the intended use of the electronic record and is not reciting any further step. This language is purely intended use language. However, Loeb determines and ensures that future payments are made to affect a renewal so this is somewhat of a moot point anyway because the art teaches what is claimed as far as the intended use of the record to determine and verify future renewal fees. This is what Loeb does by the very nature of the invention and this has been provided to Fellman. The prior art combination of record results in the payment of a fee to affect the renewal of the registration as claimed for any current registration. That is the payment for the renewal that the customer has just requested.

With respect to the accepting of a one time permanent registration fee payment for the existing domain name registration, this is not taught by Fellman modified in view of Loeb. Loeb does not mention having a one time payment for the continued and automatic renewals. The NPL article “Lifetime service now offered” discloses that in 1997 it was known in the art to accept a one time registration fee to provide for lifetime access to the Internet. This is essentially the offering of lifetime services for access to the Internet for a one time fee. The use of a one time fee for lifetime services related to the Internet is known in the art. One of ordinary skill in the art can decide how they

want to structure the payments. Loeb discusses having quarterly payments, and even discloses that a person can pay a lump sum for a multi year subscriptions (see column 2, lines 51-55). Knowing that the concept of offering lifetime services for a one time registration fee is known in the art for Internet access, one of ordinary skill in the art that wanted to also offer a lifetime service feature to their business would have found it obvious to do so. This is essentially offering lifetime services like Loeb is disclosing where there is just one payment to be made. It would have been obvious to offer the service of providing the open ended domain name registration renewals of Fellman by offering customers an option of a one-time registration fee. This allows the business to bring in some large amounts of capital at the present time in the form of a larger fee payment for the lifetimes services and would be an attractive advertising and marketing feature that could be used to attract more customers and more business. Fellman was already provided with the feature of recurring and open ended registration renewals and the additional feature of doing this for a one time registration fee would have been obvious to one of ordinary skill in the art. This is just adopting the well known business concept of providing lifetime services in exchange for a one time registration fee.

As stated previously, the claimed language regarding the use of the second portion of the fee in a financial instrument so that interest can be earned, and the use of a second portion of the payment fee to pay for all future renewal fees is not disclosed in the prior art. In the rejection of record a customer is paying a one time registration fee for a permanent (lifetime) domain name registration renewal service. When this happens there is very clearly going to be money left over after paying any currently due

renewal fees for the existing and current domain name registration renewal. When a customer requests a permanent registration renewal and pays a one time fee (that could be in the thousands of dollars or even the tens of thousands of dollars), not all of the money is needed to renew the registration at this time. This is clearly because the authoritative entity does not provide for permanent registrations and the registration term is limited in length, which is why the domain name registration needs to be periodically renewed. The registrar in Fellman is taking over the responsibility of paying for the domain name renewal in future years. A person of ordinary skill in the art would easily recognize and understand that if you received a one time fee on the order of $10,000, and you only needed maybe $50-$75 to register the domain name for another registration time period, you would have a lot of left over money. One of ordinary skill in the art would clearly be motivated to use the extra money and put it to work in the form of some kind of investment that could earn interest. This could be something as simple as an interest earning savings or checking account or an interest earning certificate of deposit. Financial instruments in the form of interest earning savings and checking accounts, as well as certificate of deposit accounts are very well known in the art and the examiner takes official notice of this fact. There is no dispute that one of ordinary skill in the art is aware of interest earning accounts such as a savings account or checking account, or even a CD that earns interest. One of ordinary skill in the art who is receiving a lump sum payment in the form of a one time registration fee that is supposed be used to pay for future renewals of a domain name registration, would need to put money aside to ensure that there is sufficient funds to pay the future renewals,

that you have already agreed to pay for, by accepting the one time registration fee from the customer for the lifetime services of a domain name registration renewal. One of ordinary skill in the art at the time the invention was made would have found it obvious to use a second portion of the payment fee that is not needed to pay any currently due registration fees and put it into a financial instrument, such as an interest earning savings account or checking account so that interest can be earned on the second portion of the payment fee and so that there is money put aside to pay any and all future registration renewal fees. This is something so basic to business in general and investing in general that it is hard to see how the use of a financial instrument such as an interest earning checking account by a business owner such as Fellman involves anything more than ordinary skill in the art.

With respect to the periodic generating of a list of domain name registrations for which renewal fees must be paid, it is noted that Loeb is using stored data on a periodic basis to determine what renewals need to be paid. This is done by a simple comparison of the present date to the date that a renewal needs to be paid by. See column 9, lines 38-55. While Loeb is paying renewals when the renewal date is less than the current date, Loeb is still teaching the idea of using stored data to periodically determine what renewals need to be paid. With a domain name registration, it is obvious that nobody wants to let the registration expire, and Loeb even recognizes that the avoidance of service disruptions is one advantage of the system. It follows that because Fellman is paying for all future domain name registration renewals and is assuming the responsibility of ensuring that they are properly paid, one of ordinary skill

in the art would find it obvious to periodically generate a list of upcoming domain name registrations that need to be paid, such as by determining what domain name registrations are going to expire tomorrow and ensuring that the payment is made prior to the expiration. This is taught by Loeb and would have been obvious to provide to Fellman. It follows that the registrations that are being determined as needing to be renewed would have an associated certificate as claimed.

With respect to the transferring of fees from the financial instrument to be able to pay the renewal fees, this would have been obvious to one of ordinary skill in the art and flows from what has already been addressed. If one of ordinary skill in the art has taken a portion of the one time fee and deposited it into an interest earning checking account, they would need to withdraw a portion of those funds to be able to pay the renewal fees in the future. After all, to be able to pay future renewal fees the operator of Fellman has placed money into an interest bearing account of some type. It would have been obvious to use the money of the financial instrument to pay for a future renewal fee by withdrawing the money from the financial instrument (that can be simply a savings or a checking account), and paying the renewal fees. Fellman and Loeb both disclose the electronic payment of fees. It would have been obvious to take the money out of the investment and use it for what it is intended to be used for, namely to pay for a future renewal fee that the operator of Fellman is providing lifetime service for, in return for the one time registration fee. The renewal fee can be a pre-determined number of renewal fees as claimed. Loeb discloses that a fee for a renewal can be paid in advance for multi term renewals (column 2, lines 51-55). The payment of a renewal

fee to renew the domain name registration for one more term satisfies what is claimed. One renewal is a predetermine number, namely one, that is a current renewal fee. Payment of a renewal satisfies what is claimed, which is just the payment of a current renewal fee at a current fee rate. The portion of the claim that recites a contract or legal agreement is only required in the alternative and is not required to satisfy what is claimed. Also, advanced payment of a number of renewal fees reads on the act of simply renewing more than one domain name for more than one customer. With respect to querying to determine that all fees have been paid, this would have been obvious so that it can be ensured that payment was received. The act of confirming payment was received for whatever registration renewals that needed to be paid would have been obvious to one of ordinary skill in the art.

With respect to the creation of an electronic permanent registration certificate (as opposed to the claimed record), this is basically a record of the fact that the provider in the form of the registrar has contractually agreed to provide lifetime services of domain name registration renewals for the customer. Taking into account that the acceptance of a one time payment in return for lifetime services of domain name registration renewal constitutes a contractual agreement, it would have been obvious to one of ordinary skill in the art to create a registration “certificate” as claimed that would explain and set forth the terms and conditions under which the agreement to provide lifetimes services has been accepted. This would be obvious so that both the operator of Fellman and the customer have a copy of the terms of the agreement. It is common place and very well known in the area of contracts that the terms and conditions of an

agreement are provided in some sort of document. That document is the equivalent to the claimed registration certificate, that is more or less explaining what rights and conditions are associated to the registration renewals. Applicant also claims that the certificate has an additional contract layer that sets forth “one or more rights". As this is best understood by the examiner, this is just a certificate that sets forth the agreement in the form of the contract for lifetime services. To provide a certificate in the form of a document that sets forth the terms and rights of each party to the agreement would have been obvious to one of ordinary skill in the art.

With respect to the claimed additional contract layer that is associated with the electronic registration certificate, applicant has recited that one or more rights are associated with the certificate. Applicant has claimed that one of the rights can be a title, an insurance policy, ownership shares, leases or subleases, and co-ownership certificates. To the extent that the claim requires a “right" be associated to the claimed certificate, one of ordinary skill in the art would recognize that one can structure a contractual agreement any way they want to and can provide for any sort of terms and conditions they desire. In this portion of the claim applicant is very clearly trying to patent the terms and conditions of the contractual agreement under which the lifetime renewal services are to be provided. The rights that are claimed have been addressed below.

For claims 1,4,5, not disclosed is that an “insurance policy” or a “title” is (or can be) issued with the permanent registration certificate, where the insurance policy or title covers losses associated with not properly renewing a domain name registration.

Insurance (applicant calls it a title in claims 1,5) is well known in the art as being used to protect and cover an individual against some kind of loss. Insurance is used with things such as cars (liability and comprehensive coverage), houses (homeowners insurance), medical malpractice insurance for a practicing physician, and even insurance on a loan such as mortgage insurance. An insurance policy can be taken out for just about any situation one can think of. One of ordinary skill in the art would recognize and understand that one can insure anything against any kind of loss. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide insurance to the customer that protects them against possible failure to renew their domain name registration. A registrar such as Fellman taking on the responsibility and liability for making all future renewal payments to the authoritative entity (such as ICANN) would surely want to protect themselves against a lawsuit in the event that they do not make a required payment in the future to renew a domain name registration. To use insurance as a way to cover Fellman and the customer from losses resulting from not renewing a domain name registration is something that would have been obvious to one of ordinary skill in the art. This claim is just reciting the use of insurance for what it is designed for in the first place, namely to protect against losses associated with a particular event. The kind of event that the insurance is associated with is not something that involves more than ordinary skill in the art and one of ordinary skill in the art would need to mitigate the risk associated with not renewing a domain name when it is due. This is because of the possible implications of not renewing a domain name registration that has some importance on the Internet.

For claims 1,6,8, not disclose is the issuing of shares (ownership certificates) as claimed, where the shares allow ownership interest to be sold. The examiner notes that nothing is actually being sold or distributed to more than one owner so the idea of ownership shares in a general sense is all that is claimed. Similar to claims 4 and 5, applicant did not invent the idea of ownership shares in general for something of value such as a domain name. It is well known that domain names are items of great value. One of ordinary skill would be very much aware of this fact. Applicant is using the idea of ownership shares with a domain name for the same reasons that people use ownership shares in the first place, which is to allow multiple owners to have a share in something of value. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow for shares to be sold and associated with a domain name registration as claimed. This is just taking the general idea of ownership shares, such as are used in vacation timeshares, stocks, and really anything of value and applying it to domain names. Many married persons are co-owners in their home. That is a very common and basic form of ownership shares. Providing for the mere ability to sell ownership shares for the domain names is something that would have been obvious to one of ordinary skill in the art.

For claims 1,7, not disclosed is the issuing of a lease or a sublease. Both leases and sublease are very well known in the art. The examiner notes that no leasing or subleasing is actually occurring so the general idea of a lease or sublease is addressed. One of ordinary skill in the art is very aware of the fact that things of value such as domain names can be leased. Anything can be leased. Items known as being leased

include raw materials used in a production process (Lend Lease Act of World War I), cars, gold mines, property, computers, data storage, and just about anything that one can think of. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow for leasing or subleasing to occur with domain names, so that an owner of a valuable domain name can use the domain name to generate income in the form of lease payments. This is something obvious to one of ordinary skill in the art. Applicant is just claiming the use of a lease or subleasing for what they are designed for, to allow one entity to use an asset while the original owner retains actual ownership of that asset. Applicant is claiming the use of a lease for what leases provide for in the first place. This involves nothing more than ordinary skill in the art.

With respect to the limitation regarding the use of a neutral third party for providing enforcement and resolution of disputes, this reads on the use of the judicial court system to settle any disputes. A judge is a neutral third party that can hear and settle contractual disputes. This also reads on the well known concept of having an issue decided by a neutral person called an arbitrator. When a dispute between two parties cannot be settled, it is known in the art to go to arbitration where a neutral third party decides the issue. In either case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the services of a neutral third party so provide enforcement and resolution of disputes for the contractual agreement between the customer and the operator of Fellman that is providing lifetimes services of domain name registration renewals. This portion of the claim reads on using the court

system to provide enforcement of the contract and to settle a contractual dispute. This would have been obvious.

For claim 9, not disclosed is that the registration certificate is in a format that is non-electronic. The examiner views this as providing a paper registration certificate to the customer. Because the use of paper certificates are so well known, such as paper setting forth the terms of a contract, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a paper hard copy of the registration certificate so that the customer had an actual real copy of the registration certificate for their record. Current technology has gone from paper to electronic format and claim 9 is claiming the old way of doing things, such as by providing paper registration certificates as opposed to electronic copies. This is well within the knowledge of one of ordinary skill in the art.

For claim 13, not disclosed is that the payment is made by a check or money order via the mail. This is just claiming that the payment could be made by using a check or money order by mail, both of which are old and well known in the art. It would have been obvious to one of ordinary skill in the art to allow for payments to be made by check or money order by mail, so that customers who maybe cannot pay via a credit card via the Internet can still request and render payment for domain name renewal registrations. This would allow a customer to send in a check or a money order to pay for a registration renewal.

7. Claims 19,21-24,34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellman (20020065903) in view of Loeb et al. (6014641) in view of "Lifetime service now offered" (1997) and further in view of “Lasting respects Internet sites, memorialize the departed” (10/16/1999).

For claim 34, Fellman in view of Loeb in view of “Lifetime services now offered” discloses the invention substantially as claimed, as has been addressed by the examiner above. For purposes of brevity the examiner is not restating that which has already been addressed in claim 1 which common to claim 34.

For claim 19, the limitation of accepting the domain name for which the renewal registration is requested is part of the act of renewing a domain name. The customer must inform the registrar (Fellman) of the domain name that they wish to have renewed; otherwise, they cannot renew the registration on behalf of the customer. This is necessarily required to be able to renew the domain name for the customer. This is similar to how Fellman discloses that the domain name that the customer wants to register (not necessarily a renewal) is entered via data fields on a computer interface as is shown in figure 3.

For claims 19,34, not disclosed is the step of accepting website content, accepting a one time fee for permanent web site hosting, and determining and paying all future fees associated with the domain name registration and the web site hosting service.

“Lasting respects” discloses that in 1996 it was known for a web site provider to offer *to host a memorial web site page on a permanent basis for a one time fee*. Lasting

respects discloses that Don Cazer set up a web site called "Perpetual Life Memorials" that provided customers with a web site that could be used to memorialize a deceased individual. Specifically disclosed is that for the fee of $245, one could post one photograph and one or two pages of text "*on the Internet forever*, *or for as long as the Internet exists.*". It was known in the art for a business on the Internet to act as a web site hosting provider that offered to maintain and operate a web site for an indefinite amount of time after payment of a one time fee, as was done by Perpetual Life Memorials. Perpetual Life Memorials is only one of numerous memorial web sites that were known in the art to provide for web site or web page hosting for the purpose of memorializing a deceased individual. Perpetual memorials just happen to be offering the service of permanent web site hosting for a fee of $245. The examiner also takes notice of the fact that it is well known in the art of domain name registrations and website operations for a business to offer both the act of registering a domain name and providing for the services that host a web site for that particular domain name. One of ordinary skill in the art at the time the invention was made would have found it obvious to not only provide the services of domain name registration and renewal, but to also provide for the hosting of a web site on a permanent basis. One of ordinary skill in the art would be motivated to also provide for website hosting services in addition to the domain name registration services in an effort to attract and gain more business. This inherently requires accepting of web site content as claimed. If you are going to register a domain name on behalf of a domain name owner, you might as well also try to get their business in the form of providing web site hosting services to the customer as well.

One of ordinary skill in the art would be aware of the fact that Perpetual memorials offered to maintain a memorial web site on the Internet forever, and along with the fact that a permanent domain name registration service is being offered in the rejection of record, one of ordinary skill in the art would have found it obvious to extend the permanent service aspect to the web site hosting as well. It would have been obvious to one of ordinary skill in the art to provide permanent web site hosting as claimed, and to determine and ensure that any bills associated with the permanent hosting of the web site can be paid and are taken care of in a similar manner as is done for the permanent domain name registration renewal service. This naturally flows from the act of charging a one time fee for permanent web site hosting, where part of the fee is used to maintain the web site now, and part of the fee is going to have to be used to maintain the web site in the future.

For claims 21,22, the claimed language regarding the use of a portion of the payment fee in a financial instrument so that interest can be earned is not disclosed in the prior art. In the rejection of record a customer is paying for a permanent registration and permanent web site hosting. When this happens there is going to be left over money after paying any currently due renewal fees to the authoritative entity for the domain name registration and for the current web site maintenance fees. When a customer requests a permanent website hosting and pays a fee (that could be in the thousands of dollars or even the tens of thousands of dollars), not all of the money is needed to maintain the web site at this time. A person of ordinary skill in the art would easily recognize that if you received a one time fee on the order of $10,000, and you

only needed maybe $100 to currently maintain and operate the web site, you would have a lot of left over money. One of ordinary skill in the art would clearly be motivated to use the extra money and put it to work in the form of some kind of investment. This could be something as simple as an interest earning savings or checking account or an interest earning certificate of deposit. Financial instruments in the form of interest earning savings and checking accounts, as well as certificate of deposit accounts are very well known in the art and the examiner takes official notice of this fact. There is no dispute that one of ordinary skill in the art is aware of interest earning accounts such as a savings account or checking account, or even a CD that earns interest. One of ordinary skill in the art who is receiving a lump sum payment in the form of a permanent registration payment fee and/or a permanent web site hosting fee, that is supposed be used to pay for future renewals of a domain name registration and future web site fees, would need to put that money aside to ensure that it is there to pay the future bills that you have already agreed to pay for by accepting the permanent registration fee and permanent web site hosting fee from the customer. One of ordinary skill in the art at the time the invention was made would have found it obvious to use a portion of the payment fee for the permanent web site hosting, and put it into a financial instrument, such as an interest earning savings account or checking account so that interest can be earned on the extra portion of the payment fee, and so that there is money put aside to pay any and all future registration renewal fees and/or maintenance fees for hosting the web site. This is something so basic to business in general and investing in general that it is hard to see how the use of a financial instrument such as an interest earning

checking account by a business owner such as Fellman involves anything more than ordinary skill in the art.

For claims 23,24, not disclosed is the use of multiple domain name system servers where the web site hosting is on a host other than the domain name server. The rejection of record includes the use of a web server in the form of a domain name server. One of ordinary skill in the art would readily appreciate that the functions and acts performed by the server can be distributed to one or more servers. This is very well known in the art of computing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use multiple servers, so that the concept of distributed computing can be put to good use and so that one single server is not responsible for the entire operation of the system and method. Having a server for domain name registrations and another server for web site hosting is well within the purview of one of ordinary skill in the art. This is such a well known concept that one of less than ordinary skill in the art would find this obvious. To separate the functions of domain name registration and web site hosting to two different servers would have been obvious to one of ordinary skill in the art.

Response to Arguments

8. Applicant's arguments filed 09/13/11 have been fully considered but they are not persuasive.

Due to the amendment, the rejections under 101 and 112,1st (enablement) have been overcome. The amendment makes the rejections moot, not necessarily the arguments presented in support thereof.

With respect to the new matter rejection under 112,1st paragraph that relates to the specification not disclosing that the client device has more than one processor, applicant has not amended the claim to correct this problem and has not provided any argument to rebut this new matter issue. The claim has been amended to recite "a client network device with at least one processor". This is no different than the previous language of "a client network device with one or more processors". The entirety of applicant's rebuttal for this issue is that the claim has been amended; therefore, the examiner should withdraw the rejection. That is not persuasive and the issue still remains of the specification not providing support as originally filed for the client device having more than one processor. It has not been addressed by amendment and has not been addressed at all via arguments. The rejection will be maintained.

With respect to the 112,2nd rejection and specifically with respect to claim 34, all applicant stated was that "The claims are now definite and the Section 112,2nd paragraph rejections must be immediately withdrawn". The issue for claim 34 remains unchanged and applicant has not provided any explanation at all on what the covered structure is that is recited by the 112,6th language. The examiner has nothing to

respond to and is still left wondering what the covered structure is that is defined by all of the "step for" limitations. The rejection is being maintained.

With respect to the prior art traversal, the arguments are based on amendments to the claims. The arguments are moot based on a new grounds of rejection applied to the claims in response to the substantial amendments. The examiner does need to respond to some comments however and will try to fully address all arguments as best as possible.

Applicant has alleged that the claimed invention was unpredictable, includes unexpected results, and was not obvious to try. This is found on page 34 of the remarks. Applicant cites a lot of claim language on page 35 and then again alleges that there is some unexpected result and that the invention is not predictable. No evidence has been offered to support any allegation of unexpected results or an unpredictable invention. Applicant has merely alleged in a vague and broad sense that the claims somehow define an unpredictable invention that provides unexpected results. It is noted that no explanation at all is provided, just an unsupported allegation. What are the unexpected results? Without any evidence being submitted for the examiner to consider, the argument that the invention is unpredictable and provides unexpected results is taken as nothing but an unsupported general allegation that is not persuasive. Applicant only generically argues that none of the cited art provides for a renewal system not associated with a registration system, and that no third party is used to settle a dispute. What does this have to do with anything being unpredictable or providing unexpected results? This is not clear and is not persuasive.

At the bottom of page 36 applicant alleges that the examiner has not treated all claimed limitations. Applicant is more or less just alleging that the examiner has not treated any of the claim language. It is true that the examiner has admitted that certain limitations are missing in Fellman, but that does not mean that they have not been considered or treated on the merits. The examiner has considered and treated all limitations that have been claimed. Applicant reminds the examiner of a few aspects regarding obviousness rejections and then generally alleges that the examiner has not treated the claimed limitations. Again, no actual explanation has been provided. Applicant is just alleging that there are some things that the examiner has not treated, but no specifics are given and the entire arguments amounts to nothing more than a general allegation that is not persuasive. With respect to the statement on page 38 that nobody of skill in the art would equate a domain name registration with a certificate with a contact layer (rights in an abstract sense), it is not clear what point is trying to be made here. The examiner has treated the amended claim language and the rejection of record addresses the contract layer, etc..

On pages 39-41 applicant argues that there is no suggestion or motivation to combine the references. This argument is moot based on the new grounds of rejection that are addressing the newly amended claims.

With respect to the argument on pages 41-42 that there is no reasonable expectation of success, this argument is moot based on the new grounds of rejection that are addressing the newly amended claims. Also, the argument that certain references have different interfaces and underlying architectures does not automatically

mean that they cannot be combined. This argument is not persuasive and is also moot based on the new grounds of rejection.

With respect argument on page 43 that the combination of the art teaches away, this argument is moot based on the new grounds of rejection that are addressing the newly amended claims. Applicant argues that their invention does not require any registering of a domain name and uses previously registered domain names and Fellman teaches away from this. It is not clear to the examiner how Fellman teaches away from providing a domain name renewal, which also happens to be very well known in the art prior to the filing date of the instant application. Arguing that Fellman can only be used for an initial registration is not persuasive in the least. The rejection of record addresses this issue in detail, which applicant is referred to.

On page 45 applicant has a conclusion for claims 1 and 34 that states that the claimed invention "is not predictable and includes unexpected results that are not obvious in view of KSR". No showing of any kind has been made to support this vague assertion. This is not persuasive.

For claims 9 and 13, the remarks on pages 45-46 basically argue that the claims are not taught by the prior art. No discussion at all is provided, just an allegation. No actual argument has been presented that traverses what is claimed in claims 9 and 13.

With respect to the comments regarding the taking of official notice, they are not persuasive. Is the examiner really to believe that applicant is traversing the fact that savings accounts and checking accounts at banks are well known in the art? That is the issue at hand in the official notice and the examiner finds is incredibly hard to

believe that applicant is seriously attempting to argue that it is not known in the art that one can place their money into an investment that can earn interest, such as a savings account at a bank. However, the specific traversal provided will be addressed in total. Applicant states on page 47 that there are several errors with the examiners use of official notice. Applicant then argues that the examiner has not provided any documentary evidence that supports the official notice. This is not an error with the assertion set forth by the examiner. Applicant is really trying to just argue that the examiner has to cite a reference even when applicant does not challenge the assertion itself. Applicant argues that the examiner is in violation of *In re Ahlert* because the examiner admitted that the prior art does not teach that feature. That is not persuasive. The mere fact that the prior art lacks a feature does not mean that any taking of official notice for that feature is improper. Again, applicant is not actually saying that the examiner is wrong, applicant is demanding evidence. This is not persuasive and is not addressing the merits of the official notice. The alleged traversal of the official notice is not a traversal at all. It is simply a demand for evidence while not addressing the comments from the examiner. The alleged traversal is not a traversal and the official notice is deemed proper.

With respect to the remaining argument on pages 49-52, they are not persuasive. Applicant is just generally referring to the claimed terms of a registration certificate that has the contract layer with rights, etc.. This is addressed in the rejection of record.

The arguments are not persuasive.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689